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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,884	02/16/2001	Thomas S. Buszta	IR 3593 NP	5207

7590 11/20/2003
Gilbert W. Rudman
ATOFINA Chemicals, Inc.
Patent Department - 26th Floor
2000 Market Street
Philadelphia, PA 19103-3222

EXAMINER	
MEDLEY, MARGARET B	
ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/784,884	Applicant(s) BUSZTA ET AL.
	Examiner Margaret B. Medley	Art Unit 1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 July 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5,7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5,7,9 and 10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>11/03</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to the amendment filed on July 14, 2003.

The amendment to claims 1 and 9-10 and the addition of claim 11 has been entered of record. The pending claims of record are claims 1-5, 7, and 9-11.

Newly submitted claim 11 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 10 is directed to a synthetic rubber latex Classified in Class 520 and 528 that is a different and distinct invention than the invention of claims 1-5, 7 and 9 directed to a composition for shortstopping free radical emulsion polymerization of synthetic rubber latexes classified in Class 523 that were originally presented and have been given an action thereon.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

It would create an undue burden on the office for the examiner to search another distinct and different invention

This application contains claim 11 drawn to an invention nonelected. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 10 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim 11 has been withdrawn from consideration and has not been given an action on the merit.

In view of the amendment to claims 1 and 9, the 35 U.S.C. 112 second paragraph rejection has been withdrawn.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7 and 9-10 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson 4,293,672 for reasons made of record in Paper No. 2 dated October 23, 2002.

Claims 1-5, 7 and 9-10 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Miller 4,654,450 for reasons made of record in Paper No. 2 dated October 23, 2003.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 7 and 9-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,495,065 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the shortstopping composition comprising a hydrophilic alkyl hydroxylamine and hydrophobic free radical shortstopping agent alkyl hydroxylamine of applicants anticipate and/or render obvious the composition for shortstopping free radical emulsion polymerizations comprising nitrosamine and wherein the shortstopping agent is diethyl hydroxylamine and or dibutylamine of patentee.

On November 14, 2003 in a telephone interview with applicants' representative he informed the examiner that the submission of the terminal disclaimer on page 10 of the July 14, 2003 amendment was inadvertently not submitted to the PTO.

Applicant's arguments filed July 14, 2003 have been fully considered but they are not persuasive.

The arguments that Jackson does not teach a specific mixture of at least one hydrophilic alkylhydroxylamine and at least one hydrophobic free radical shortstopping agent is not convincing in that the claims are not drafted to distinguish the claims from the Jackson reference because claim1 does not distinguish the hydrophilic agent from the hydrophobic agent in term of the alkyl group.

The arguments that Miller does not teach a specific mixture of at least one hydrophilic alkylhydroxylamine and at least one hydrophobic free radical shortstopping agent is not convincing in that the claims are not drafted to distinguish the claims from the Jackson reference because claim1 does not distinguish the hydrophilic agent from the hydrophobic agent in term of the alkyl group. Further the instant claims as drafted contain the open-ended language "comprising" that would not exclude the alkyl benzene sulfonic acid of Miller.

The double patent rejection over Patentees U.S. 6,495,065 is maintained until applicants submit a proper terminal disclaimer with the proper fees.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday-Friday from 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Margaret B. Medley
Margaret B. Medley
Primary Examiner
Art Unit 1714

MBMedley
Nov. 14, 2003